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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

YOUNG, JOHN L

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/520,798

Filing Date: March 8, 2000

Appellant(s): Richard Rothkopf

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GROUP 3600

Vincent M. DeLuca, Reg. No. 32,408
For Appellant

EXAMINER'S ANSWER

This is in response to Appellant's brief on appeal filed March 10, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement indicating that there are no related appeals and interferences is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

Claims 1-13, 15-21 & 23-25 are pending.

(4) *Status of Amendments After Final*

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The Appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

AGREEMENT WITH APPELLANT'S STATEMENT OF GROUPING OF CLAIMS

The Office finds agreement with Appellant's statement of the grouping of the claims as provided in the instant appeal brief arguments.

(8) *Claims Appealed*

COPY OF APPEALED CLAIMS IN APPENDIX IS CORRECT

A correct copy of appealed claims appears in Appellant's brief.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejections of claims under appeal.

Number	Name	Date
US 6,251,017	Leason et al.	June 26, 2001
US 5,862,325	Reed et al.	January 19, 1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13, 15-21, & 23-25 stand rejected under 35 U.S.C. 103(a).

These rejections are set forth in the prior Office Actions as follows:

CLAIM REJECTIONS —35 U.S.C. §103(a)

3. Rejections Maintained.

REVISED 35 U.S.C. §103(a) REJECTIONS

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Independent claims 1, 10 & 19 and dependent claims 2-9, 11-13, 15-18 & 20-21 & 23-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leason et al. 6,251,017 (6/26/2001) [US f/d: 4/21/1999] (herein referred to as "Leason") in view of Reed et al. 5,862,325 (1/19/1999) (herein referred to as "Reed").

As per claim 1, Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest "An electronic commerce apparatus for offering a promotional award to a visitor of an electronic commerce site, comprising: a connection to a distributed communication network; at least one promotional awards storage area, including a customer identifier storage and an award amount storage; and an awards rule storage; wherein said visitor is granted a promotional award upon visiting said electronic commerce site, said promotional award amount being controlled by an awards rule contained in said awards rule storage, and said promotional award amount being stored in said promotional awards storage area."

Leason lacks an explicit recitation of all of the elements and limitations of claim 1, even though Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35): *"The present invention is an improvement over conventional promotional games and lotteries in that it provides . . . an incentive to visit a designated [Internet] site or service. . . . The customer is rewarded for visiting the designated [Internet] site(s) with a benefit that can be redeemed. . . . [or] awarded with a number of e-points. . . . The e-points are exchangeable for limited access to predetermined sites or services on the [Internet]. . . . players validate their e-point awards or register their validation codes. . . . at the time of e-point redemption. . . ."* would have been selected in accordance with the elements and limitations of claim 1 because such selection would have provided *"an incentive to visit a designated [Internet] site or service. . . . The customer is rewarded for visiting the designated [Internet] site(s) with a benefit that can be redeemed. . . . [or] awarded with a number of e-points. . . ."* (See Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35)).

Leason lacks an explicit recitation of:

unique identification information for each visitor to said site, and a visitor parameter storage that contains information pertaining to prior visits to said site by visitors identified in said customer identifier storage; and an awards rule storage that stores rules for crediting awards to visitors of said site according to information stored in said visitor parameter storage. . . . retrieving visitor parameter information from said visitor parameter storage corresponding to customer identification information stored in said customer identifier storage in response to visitor identification information provided to said apparatus upon visitor access to said site, and applying retrieved visitor parameter information to award crediting rules retrieved from said awards rule storage.

Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) in view of Leason shows elements that suggest:

unique identification information for each visitor to said site, and a visitor parameter storage that contains information pertaining to prior visits to said site by visitors identified in said customer

identifier storage; and an awards rule storage that stores rules for crediting awards to visitors of said site according to information stored in said visitor parameter storage. . . . retrieving visitor parameter information from said visitor parameter storage corresponding to customer identification information stored in said customer identifier storage in response to visitor identification information provided to said apparatus upon visitor access to said site, and applying retrieved visitor parameter information to award crediting rules retrieved from said awards rule storage.

Reed proposes parameter storage modifications that would have applied to the lottery reward system of Leason. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Reed with the teachings of Leason because such combination would have provided means “*to automate control of underlying communication operations. . . .*” (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is*

in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.” (See Leason (col. 2, ll. 1-6)).

As per claim 2, Leason in view of Reed shows the system of claim 1.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 2.

Leason lacks an explicit recitation of “wherein said visitor parameter storage comprises a number of previous visits storage that stores a number corresponding to the total number of visits to said site by a particular visitor, and wherein said awards rule storage stores an awards rule that determines a specific promotional award based on a number of previous visits to said site by a visitor as stored in said number of previous visits storage. . . .” even though Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “wherein said visitor parameter storage comprises a number of previous visits storage that stores a number corresponding to the total number of visits to said site by a particular visitor, and wherein said awards rule storage stores an awards rule that

determines a specific promotional award based on a number of previous visits to said site by a visitor as stored in said number of previous visits storage. . . .” because such selection would have provided means *“to automate control of underlying communication operations. . . .”* (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means *“for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .”* (see Leason (col. 2, ll. 30-33)), and such selection would have provided *“a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.”* (See Leason (col. 2, ll. 1-6)).

As per claim 3, Leason in view of Reed shows the system of claim 1.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) shows elements that suggest the elements and limitations of claim 3.

Leason lacks an explicit recitation of “wherein said visitor parameter storage comprises an award time storage that stores a time of a last award to a particular visitor, and wherein said awards rule storage stores an awards rule that determines a specific

promotional award based on whether a predetermined time period has elapsed since said last award. . . .” even though Leason in view of Reed suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “wherein said visitor parameter storage comprises an award time storage that stores a time of a last award to a particular visitor, and wherein said awards rule storage stores an awards rule that determines a specific promotional award based on whether a predetermined time period has elapsed since said last award. . . .” because such selection would have provided means “*to automate control of underlying communication operations. . . .*” (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 4, Leason in view of Reed shows the system of claim 1.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) shows elements that suggest the elements and limitations of claim 4.

Leason lacks an explicit recitation of “wherein said visitor parameter storage comprises an award amount storage that stores a cumulative total value of awards credited to a particular visitor, and wherein said awards rule storage stores an awards rule that determines a specific promotional award based on the cumulative total award value stored in said award amount storage. . . .” even though Leason in view of Reed suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “wherein said visitor parameter storage comprises an award amount storage that stores a cumulative total value of awards credited to a particular visitor, and wherein said awards rule storage stores an awards rule that determines a specific promotional award based on the cumulative total award value stored in said award amount storage. . . .” because such selection would have provided means “*to automate control of underlying communication operations. . . .*” (see Reed (col. 9, ll. 30-33)), and because

such combination would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 5, Leason in view of Reed shows the system of claim 4.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) shows elements that suggest the elements and limitations of claim 5.

Leason lacks an explicit recitation of “wherein said award amount rule contains a predetermined promotional award limit. . .” even though Leason in view of Reed suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “wherein said award amount rule contains a predetermined promotional

award limit. . . .” because such selection would have provided means “*to automate control of underlying communication operations. . . .*” (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 6, Leason in view of Reed shows the system of claim 5.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) shows elements that suggest the elements and limitations of claim 6.

Leason lacks an explicit recitation of “wherein said award limit is reset to zero when said visitor makea a purchase from said site. . . .” even though Leason in view of Reed suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9;

col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “wherein said award limit is reset to zero when said visitor makes a purchase from said site. . . .” because such selection would have provided means “*to automate control of underlying communication operations. . . .*” (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 7, Leason in view of Reed shows the system of claim 2.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) shows elements that suggest the elements and limitations of claim 7.

Leason lacks an explicit recitation of “wherein said promotional award according to said awards rule increases with successive visits by said visitor. . . .” even though Leason in view of Reed suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with "wherein said promotional award according to said awards rule increases with successive visits by said visitor. . . ." because such selection would have provided means "*to automate control of underlying communication operations. . . .*" (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means "*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*" (see Leason (col. 2, ll. 30-33)), and such selection would have provided "*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*" (See Leason (col. 2, ll. 1-6)).

As per claim 8, Leason in view of Reed shows the system of claim 1.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) shows elements that suggest the elements and limitations of claim 8.

Leason lacks an explicit recitation of “wherein said promotion award is credited to a purchase price of a purchase by said customer. . . .” even though Leason in view of Reed suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) would have been selected in accordance with “wherein said promotion award is credited to a purchase price of a purchase by said customer. . . .” because such selection would have provided means “*to automate control of underlying communication operations. . . .*” (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 9, Leason in view of Reed shows the system of claim 1.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) in view of Reed (col. 6, ll. 48-67; col. 7, ll. 1-10; col. 78, ll. 25-67; col. 82, ll. 36; the ABSTRACT; FIG. 1; FIG. 3; FIG. 7; FIG. 11; FIG. 15; FIG. 20; FIG. 34A; and FIG. 35) shows elements that suggest the elements and limitations of claim 9.

Leason lacks an explicit recitation of “wherein said apparatus is connected through said connection to the Internet. . . .” even though Leason in view of Reed suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “wherein said apparatus is connected through said connection to the Internet. . . .” because such selection would have provided means “*to automate control of underlying communication operations. . . .*” (see Reed (col. 9, ll. 30-33)), and because such combination would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is*

in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.” (See Leason (col. 2, ll. 1-6)).

As per claim 10, Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest “A method for offering a promotional award to a visitor to an electronic commerce site, comprising the steps of: detecting a site visit by a visitor and keeping track of a number of visits to said site and a number of purchases from said site by individually identified visitors; and; granting a promotional award to said visitor in accordance with award rules pertaining to the number of visits to said site by said visitor and purchases from said site by said visitor; wherein said visitor is motivated to make multiple site visits and a purchase as a result of said promotional award.”

Leason lacks an explicit recitation of all of the elements and limitations of claim 10, even though Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35): “*The present invention is an improvement over conventional promotional games and lotteries in that it provides . . . an incentive to visit a designated [Internet] site or service. . . . The customer is rewarded for visiting the designated [Internet] site(s) with a*

benefit that can be redeemed. . . . [or] awarded with a number of e-points. . . . The e-points are exchangeable for limited access to predetermined sites or services on the [Internet]. . . . players validate their e-point awards or register their validation codes. . . . at the time of e-point redemption.” would have been selected in accordance with the elements and limitations of claim 10 because such selection would have provided “*an incentive to visit a designated [Internet] site or service. . . . The customer is rewarded for visiting the designated [Internet] site(s) with a benefit that can be redeemed. . . . [or] awarded with a number of e-points. . . .*” (see Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35)), and because such selection would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 11, Leason shows the system of claim 10.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 11.

Leason lacks an explicit recitation of “wherein said promotional award increases with each site visit by said visitor. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “wherein said promotional award increases with each site visit by said visitor. . . .” because such selection would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 12, Leason shows the system of claim 10.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 12.

Leason lacks an explicit recitation of “said promotional award increases incrementally with each site visit by said visitor. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “said promotional award increases incrementally with each site visit by said visitor. . . .” because such selection would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 13, Leason shows the system of claim 10.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 13.

Leason lacks an explicit recitation of “said promotional award is cumulative over successive site visits by said visitor. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in

accordance with “said promotional award is cumulative over successive site visits by said visitor. . . .” because such selection would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 15, Leason shows the system of claim 10.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 15.

Leason lacks an explicit recitation of “said promotional award is granted to said visitor if said visitor has not exceeded a predetermined promotional award limit. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “said promotional award is granted to said visitor if said visitor has not exceeded a predetermined promotional award limit. . . .” because such selection would

have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 16, Leason shows the system of claim 10.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 16.

Leason lacks an explicit recitation of “said promotional award is credited to a purchase price of a purchase by said visitor. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “said promotional award is credited to a purchase price of a purchase by said visitor. . . .” because such selection would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards*

are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.” (See Leason (col. 2, ll. 1-6)).

As per claim 17, Leason shows the system of claim 10.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 17.

Leason lacks an explicit recitation of “said visitor must affirmatively select the promotional award. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “said visitor must affirmatively select the promotional award. . . .” because such selection would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 18, Leason shows the system of claim 10.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 18.

Leason lacks an explicit recitation of "said electronic commerce site is accessed via the Internet. . . ." even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with "said electronic commerce site is accessed via the Internet. . . ." because such selection would have provided means "*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*" (see Leason (col. 2, ll. 30-33)), and such selection would have provided "*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*" (See Leason (col. 2, ll. 1-6)).

As per claim 19, Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest "A method for

offering a promotional award to a visitor of an electronic commerce site, comprising the steps of: detecting a site visit by a visitor and storing information identifying a visitor and identifying proper promotional awards credited to said visitor; determining whether said visitor has already exceeded a predetermined promotional award limit; granting a promotional award to said visitor if said visitor has not exceeded said predetermined promotional award limit and updating the value of said prior credited promotional awards associated with visitor identification information wherein said visitor is motivated to make multiple site visits and a purchase as a result of said promotional award.”

Leason lacks an explicit recitation of all of the elements and limitations of claim 19, even though Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35): “*The present invention is an improvement over conventional promotional games and lotteries in that it provides . . . an incentive to visit a designated [Internet] site or service. . . . The customer is rewarded for visiting the designated [Internet] site(s) with a benefit that can be redeemed. . . . [or] awarded with a number of e-points. . . . The e-points are exchangeable for limited access to predetermined sites or services on the [Internet]. . . . players validate their e-point awards or register their validation codes. . . . at the time of e-point redemption.*” would have been selected in accordance

with the elements and limitations of claim 19 because such selection would have provided *“an incentive to visit a designated [Internet] site or service. . . . The customer is rewarded for visiting the designated [Internet] site(s) with a benefit that can be redeemed. . . . [or] awarded with a number of e-points. . . .”* (See Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35)).

As per claim 20, Leason shows the system of claim 19.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 20.

Leason lacks an explicit recitation of “said promotional award increases with each site visit by said visitor. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “said promotional award increases with each site visit by said visitor. . . .” because such selection would have provided means *“for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .”* (see Leason (col. 2, ll. 30-33)), and such selection would have provided *“a method in which rewards are distributed*

to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.” (See Leason (col. 2, ll. 1-6)).

As per claim 21, Leason shows the system of claim 19.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 21.

Leason lacks an explicit recitation of “said promotional award increases incrementally with each site visit by said visitor. . . .” even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with “said promotional award increases incrementally with each site visit by said visitor. . . .” because such selection would have provided means “*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*” (see Leason (col. 2, ll. 30-33)), and such selection would have provided “*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*” (See Leason (col. 2, ll. 1-6)).

As per claim 23, Leason shows the system of claim 19.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 23.

Leason lacks an explicit recitation of "said visitor must affirmatively select the promotional award. . . ." even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with "said visitor must affirmatively select the promotional award. . . ." because such selection would have provided means "*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*" (see Leason (col. 2, ll. 30-33)), and such selection would have provided "*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*" (See Leason (col. 2, ll. 1-6)).

As per claim 24, Leason shows the system of claim 19.

Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) shows elements that suggest the elements and limitations of claim 24.

Leason lacks an explicit recitation of "said promotional award is credited to a purchase price if said visitor makes a purchase. . . ." even though Leason suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) would have been selected in accordance with "said promotional award is credited to a purchase price if said visitor makes a purchase. . . ." because such selection would have provided means "*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*" (see Leason (col. 2, ll. 30-33)), and such selection would have provided "*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online.*" (See Leason (col. 2, ll. 1-6)).

As per claim 25, Leason shows the system of claim 19.

Leason lacks an explicit recitation of the elements and limitations of claim 25, even though Leason (the ABSTRACT; FIG. 3; FIG. 5; col. 1, ll. 5-9; col. 2, ll. 1-19; col. 2, ll. 30-55; and col. 12, ll. 27-35) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Leason (the ABSTRACT; FIG. 3; col. 2, ll. 1-56; and col. 12, ll. 27-35) would have been selected in accordance with "said electronic commerce site is accessed via the Internet. . . ." because such Internet connection would have provided "*a method in which rewards are distributed to players with a code that permits them to validate the reward online, and if the reward is in the form of access to otherwise restricted [Internet] sites or services, to redeem the reward online. . . .*" (see Leason (col. 2, ll. 1-6)); and because such selection would have provided means "*for encouraging a customer to go online and visit one or more designated [I]nternet sites. . . .*" (see Leason (col. 2, ll. 30-33)).

(11) Response to Arguments

Appellant's arguments (Appeal Brief, paper#14, filed 04/29/2003) concerning the obviousness rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

Appellant's argument (Appeal Brief, paper#14, p. 5) alleges that the "rejection . . . under 35 U.S.C. § 103(a) over Leason in view of Reed is improper. . . . [and that]

Leason does not disclose a method or apparatus for providing promotional awards to a visitor of an electronic commerce site. . . .” This is not the case. ”

Appellant’s argument (Appeal Brief, paper#14, p. 5, ll. 5-7) admits that “Leason is directed to a method for encouraging individuals to visit designated web sites . . . that is where any similarity to the present invention ends.”

Appellant’s argument (Appeal Brief, paper#14, p. 6, ll. 1-11; and p. 8, ll. 16-19) asserts that “The final Office action acknowledges that Leason ‘lacks an explicit recitation of all the elements and limitations’ of the claims on appeal.” However,

Taken in the context of the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 and the 35 USC §103(a) obviousness rejection requirements, the prior Office Action recitations of “Leason lacks an explicit recital. . . .” of the features at issue does not constitute an admission of any deficiency in the relied upon reference; to the contrary such recitations merely provide the transition phraseology to the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459 and to the 35 USC §103(a) Obviousness proposition that even though the Leason reference does not explicitly recite the claimed elements and limitations, the reference does in fact suggest the claimed elements and limitations of the instant invention; and therefore, the elements and limitations of the instant invention are rendered obvious.

Appellant's argument (Appeal Brief, paper#14, p. 6, ll. 1-11) alleges that "in addition to the admitted lack of any explicit disclosure, Leason also fails to provide any implicit suggestion to those skill in the art to have arrived at the claimed invention. . . . 'Leason . . . does not show elements that suggest [the invention set forth in claim 1].'"

Furthermore, Appellant's argument (Appeal Brief, paper#14, p. 5, ll. 7-8) alleges that "Leason does not disclose a method or apparatus for providing promotional awards to a visitor of an electronic commerce site. . . ." This is not the case.

Leason (the ABSTRACT; and col. 2, ll. 45-50) recites: "*A method for conducting a promotional game or lottery in which the awards are access[sic] to one or more predetermined internet[sic]-based services or sites.*"

Appellant's argument (Appeal Brief, paper#14, p. 5, ll. 7-10) alleges that "Leason does not disclose "keeping track of the identity of visitors to the site. . . ." This is not the case. In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which applicant relies (i.e., "keeping track of the identity of visitors to the site. . . .") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case claim 1 recites: "a promotional awards storage area, including a customer identifier storage that contains unique identification information for each visitor to said site. . . ." The wording of

claim 1 is drafted so broadly that it reads on Leason (FIG. 11, el. 1102) which is a validation code that serves as “a customer identifier. . . .”; furthermore,

Leason (col. 2, ll. 45-57) recites: *“This method provides a customer with a . . . visible validation code. . . . [and] a plurality of validation codes stored at a remote site.”*

In this case, the Examiner interprets this disclosure as “customer identifier storage. . . .” as well as “a promotional awards storage area. . . .” and “storing visitor parameter information. . . .”; also,

Leason (col. 2, ll. 57-67; and col. 3, ll. 1-) recites: *“the invention provides a method for rewarding customers with access to designated internet[sic] sites and services based upon purchase transactions made in a retail store. . . . The e-points are decremented in response to use of such designated sites or services. . . . [and] The number of e-points may be decremented in response to use of the selected site or service. . . .”*; also,

Leason (col. 4, ll. 19-30) recites: *“an award of e-points can be determined based upon details form a purchase transaction of a customer.”*

It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

In this case, the Examiner interprets the above disclosures of Leason as reasonably suggesting “keeping track of the identity of visitors to the site, storing visitor parameter information pertaining to prior visits of identified visitors to the site, and crediting promotional awards by applying defined awards rules to the visitor parameter information stored for each visitor to the electronic commerce site.”

In response to Appellant's argument (Appeal Brief, paper#14, p. 5, ll. 13-22) which alleges that “no identification of the visitor is performed. . . .”, it is well settled in the law that claims are interpreted in light of the specification; however, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, Appellant's claim 1 fails to explicitly claim “identification of the visitor. . . .” The wording of the claim is drafted so broadly (i.e., “unique identification information. . . .”) that it reads on Leason (FIG. 11, el. 1102) which is a validation code that serves as “a customer identifier. . . .”

Appellant's argument (Appeal Brief, paper#14, p. 6, ll. 12-21; p. 7, ll. 13-21; and p. 8, ll. 1-5) alleges that the prior Office Action fails to provide proper motivation to combine references. This is not the case.

It is well settled in the law that “It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. *In re*

Lintner, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). . . ." (See MPEP 2144

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2100-127); furthermore,

It is well settled that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, and throughout the prior office actions and in the rejections supra the Examiner has relied upon the knowledge generally available to one of ordinary skill in the art and the Examiner has detailed with particularity where the features of the claims are suggested in the prior art references and where there are teachings in the references to modify and/or combine the references to derive the present invention.

Appellant's argument (Appeal Brief, paper#14, p. 7, ll. 1-7) alleges that impermissible hindsight is used in the obviousness rejections of the prior Office Action. This is not the case.

It is well settled in the law, that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into

account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the Examiner has relied upon the knowledge generally available to one of ordinary skill in the art and the disclosures of the applied prior art references to derive obviousness. The Examiner in the prior Office Action obviousness rejections of the instant invention has not gleaned any knowledge from the Applicant's disclosure.

Appellant's argument (Appeal Brief, paper#14, p. 8, ll. 6-19) alleges that "Reed . . . [does not provide] any disclosure of any of the features of the claimed invention. . . ." This is not the test.

Recall, it is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989); also,

It is well settled that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is not required that Reed explicitly provide "any disclosure of any of the features of the claimed invention. . . ." It is required that Reed suggest features of the claimed invention. For example,

Reed (col. 78, ll. 25-67) recites: "*When the user next connects to the web server with the browser, the web server can interrogate the browser for the cookie and use it to identify the user. The cookie can additionally store preference data about the user. . . .*"

In this case, the Examiner interprets this disclosure about "cookies" as suggesting:

"unique identification information for each visitor to said site, and a visitor parameter storage that contains information pertaining to prior visits to said site by visitors identified in said customer identifier storage. . . ." Therefore, Reed suggests features of the claimed invention.

Appellant's argument (Appeal Brief, paper#14, p. 7, ll. 11-12) alleges that "Reed is completely irrelevant to the Leason system and irrelevant to the claimed invention." This is not the case.

It has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Recall, Reed (col. 78, ll. 25-67) recites: *"When the user next connects to the web server with the browser, the web server can interrogate the browser for the cookie and use it to identify the user. The cookie can additionally store preference data about the user. . . ."* In this case, the Examiner interprets this disclosure about "cookies" as suggesting: "unique identification information for each visitor to said site, and a visitor parameter storage that contains information pertaining to prior visits to said site by visitors identified in said customer identifier storage. . . ." Therefore, Reed suggests features of the claimed invention; and therefore, Reed is reasonably pertinent to the particular problem with which the Applicant is concerned and therefore relevant to the Leason system, as well as, the claimed instant invention.

Appellant's argument (Appeal Brief, paper#14, p. 8, ll. 20-21; and p. 9, ll. 1-11) alleges that "The 34 page Advisory action [paper#10] mailed January 9, 2003 does not rebut any of Appellant's arguments pointing out the deficiencies in the prior art references relied upon and the deficiencies in the basis for the rejection as set forth in the final Office action. The Advisory action states that the Examiner is not persuaded by Appellant's arguments 'because they amount to a general allegation . . . that . . . the claims define a patentable invention without specifically pointing out how the claim language distinguishes over the prior art.'" This is not the case.

Pages 28-32 of the Advisory action (paper#10) present detailed analysis including legal precedents in rebuttal of Applicant's arguments submitted in paper#8 Request for Reconsideration.

Furthermore, Appellant's argument (Appeal Brief, paper#14, p. 9, ll. 6-11) amounts to a general allegation that the claims of the instant invention define a patentable invention without specifically pointing out how the claim language distinguishes over the prior art.

Appellant's argument (Appeal Brief, paper#14, p. 9, ll. 12-20; and p. 10, ll. 1-2) alleges that the prior Office Action (paper#7) fails to establish a *prima facie* case of obviousness. This is not the case.

It is well settled that the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the teachings of the references would have suggested in the broadest interpretation to those of ordinary skill in the art. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

It is also well settled in the law that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); and

It is well settled that:

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(a) the relevant teachings of the prior art relied upon,
preferably with reference to the relevant column or page number(s)
and line number(s) where appropriate,

(B) the difference or differences in the claim over the
applied reference(s),

(C) the proposed modification of the applied reference(s)
necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at
the time the invention was made would have been motivated to
make the proposed modification.

To establish a *prima facie* case of obviousness, three basic
criteria must be met. First, there must be some suggestion or
motivation, either in the references themselves or in the knowledge
generally available to one of ordinary skill in the art, to modify the
reference or to combine reference teachings. Second, there must be
a reasonable expectation of success. Finally, the prior art reference
(or references when combined) must teach or suggest all the claim
limitations. The teaching or suggestion to make the claimed
combination and the reasonable expectation of success must both
be found in the prior art and not based on applicant's
disclosure. . . . (See MPEP 706.02(j)).

In this case, the Prior Office Action relies upon the combined teachings, suggestions and
motivations found in the references as well as the knowledge generally available to one of

ordinary skill in the art and does not include knowledge gleaned from the Applicant's disclosure.

Furthermore, the Prior Office Action indicates the requisite "reasonable expectation of success" is established by virtue of combining the teachings of allowed patents to Leason in view of Reed.

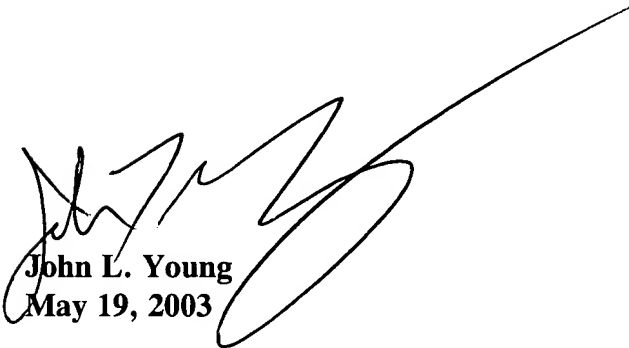
Furthermore, the combination of the teachings in prior art references suggest all the claim limitations. Finally, the teachings and suggestions to make the claimed combinations and the reasonable expectation of success are both found in the prior art and not based on Applicant's disclosure.

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Filing Date: March 8, 2000
Appellant: Richard Rothkopf

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(12) Examiner's Answer, Conclusion

For all of the reasons stated above, Appellant's brief fails to overcome the rejections of claims 1-13, 15-21 & 23-25. For the above reasons, the rejections must be sustained.



John L. Young
May 19, 2003

JLY 02/24/2003 (conf.)

SG (conf.) *smc*

KL (conf.) *klh*

Respectfully, presented,



STEPHEN GRAVINI
PRIMARY EXAMINER

Vincent M. DeLuca
Rothwell, Figg, Ernst & Manbeck, P.C.
Washington, D.C. 20005